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EXAMINER

BERMAN, A

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

01/17/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/277,226

Applicant(s)

BARA ET AL.

Examiner

Alysia Berman

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-60 and 62-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 and 62-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Receipt is acknowledged of the amendment filed November 2, 2000. Claims 1, 2, 18, 21, 24, 25, 27, 30, 32, 36, 43, 50, 51, 52, 56, 60 and 66 have been amended. Claim 61 has been canceled. Claim 67 has been added. Claims 1-60 and 62-67 are pending.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11, 38, 50, 53 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The terms "reducing", "eliminating" and "improving" in claims 1 and 2 are relative terms which render the claims 1-11 indefinite. The terms "reducing", "eliminating" and "improving" are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be

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reasonably apprised of the scope of the invention. Relative to what is the transfer, migration or staying powder of the composition being changed?

6. Claim 38 is indefinite because it recites the units  $R_3SiO_{1/2}$ ,  $R_2SiO_{2/2}$ ,  $RSiO_{3/2}$  but does not define "R". The metes and bounds of the claim cannot be determined.

7. Claims 50, 53 and 54 are indefinite because of the term "Nylon" in claim 50, line 5. Because the term is capitalized, it is unclear if this represents a tradename.

Clarification is requested. Amendment claim 50 to "nylon" would overcome this rejection.

***Claim Rejections - 35 USC § 102***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1, 2, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 374 332 ('332).

This rejection is maintained for reasons of record. See paper no. 7.

10. Claims 1, 2, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 331 833 ('833).

This rejection is maintained for reasons of record. See paper no. 7.

11. Claims 1-14, 23, 25, 27-30, 32, 34-37, 39, 40, 42-50, 56-60 and 62-66 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 819 426 A2 ('426).

EP '426 discloses alpha,omega-polyetherpolysiloxanes (alpha,omega substituted oxyalkylenated silicones) for use as emulsifiers in water/oil emulsion cosmetic or

antiperspirant compositions in an amount from 0.1wt.% to 20wt.% (abstract and page 2, lines 1-2)). For additives such as dyestuff (colorants), perfumes and stabilizers, see page 2, lines 16-22. For water-in-silicone oil emulsion for hair and skin comprising 1-50wt.% polydimethylsiloxanes, 0.1-20wt.% polyoxyethylenated/polyoxypropylenated silicone emulsifiers corresponding to the formula of claims 3-9 and 12 and an alcohol, see page 2, line 53 to page 3, line 25.

For the amounts of components, see Tables 2-4. For viscosity, see page 3, lines 30-32. For the ratio of polyoxyethylene groups to polyoxypropylene groups between 100:10 to 20:80, which encompasses the ratio instantly claimed, see page 4, lines 4-5. See page 4, lines 6-8 for preferred alpha,omega substituted oxyalkylenated silicones. For linear and cyclic silicone oils, see page 4, lines 22-24. For non-silicone fatty substances, see page 4, lines 25-26. For silicone waxes, see page 4, lines 42-43 and cetyl dimethicone at Table 2, line 25 and line 43. See Table 2, lines 33-40 for active principles in the water phase. The refractive index of one component to another is functional language that is not given patentable weight. Any one of the oils, for example, is considered a film-forming compound.

### ***Response to Arguments***

12. Applicant's arguments filed November 2, 2000 have been fully considered but they are not persuasive.

13. Applicant argues that EP '332 and EP '833 do not disclose the identical substituted silicone as instantly claimed because the ethoxy and propoxy groups are in

a different order. The claims now rejected are not limited to the silicones of the formulas instantly claimed.

14. Applicant argues that EP '332 and EP '833 do not disclose the instantly claimed viscosity of the emulsion. The claims now rejected are not limited to the instantly claimed viscosity.

15. Applicant argues that EP '332 and EP 833 do not disclose the "effective amount" in order to achieve Applicant's results. The claims are directed to a composition and are not limited by any quantitative amount of silicone. The "effective amount" as instantly claimed is based on a future intended use. Compositions per se are not patentable based on a future intended use.

***Claim Rejections - 35 USC § 103***

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

17. Claims 1-19, 23-60 and 62-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 819 426 A2 ('426) in combination with EP 0 331 833 A1 ('833).

EP '426 teaches all of the limitations of the claims as stated above. It does not teach inorganic and organic pigments, lakes and dyes (claims 15-19), the polydiorganosiloxanes of claim 24, the cyclomethicones of claim 26, silicone gums and their respective molecular weights (claims 31, 33), silicone resins of claim 38, the lipophilic adjuvants of claim 41 or the amount, average particle size and shape of the fillers (claims 51-54).

EP '833 teaches silicone resins as instantly claimed at page 7, lines 56-57. Linear and cyclic silicones as instantly claimed at page 8, lines 29-52. Additional ingredients such as pigments, lipophilic vitamins, thickeners, non-silicone oils and UV screening agents are disclosed from page 9, line 5 to page 10, line 2.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of EP '426 and use the additional silicones and additives as taught by EP '833 with the expectation of a stable emulsion for use in cosmetic compositions.

18. Claims 1-23, 25, 27-37, 39-60 and 62-66 rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 819 426 A2 ('426) in combination with US 5,593,680 (680).

EP '426 teaches all of the limitations of the claims as stated above. EP '426 does not teach inorganic and organic pigments, lake and dyes (claims 15-22), the polydiorganosiloxanes of claim 24, the cyclomethicones of claim 26, silicone gums and their respective molecular weights (claims 31, 33), silicone resins of claim 38, the lipophilic adjuvants of claim 41 or the amount, average particle size and shape of the fillers (claims 51-54).

Applicants admit at page 1, lines 12-14 that fillers and pigments are conventionally used in cosmetic compositions. US '680 that dyes such as ponceau disodium salt, alizarin green disodium salt, quinoline yellow, amaranth trisodium salt, tartrazine disodium salt, rhodamine monosodium salt, fuchsin disodium salt and xanthophyll are conventionally used in cosmetic compositions. It is within the skill in the

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art to select optimal parameters in a composition in order to achieve a beneficial effect.

*In re Boesch*, 205 USPQ 215 (CCPA 198). Therefore, the amounts of ingredients as instantly claimed are not given patentable weight absent evidence of unexpected and superior results.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of EP '426 and use the dyes taught by US '680 with the expectation of obtaining a suitably colored water-in-silicone oil emulsion cosmetic composition.

### ***Response to Arguments***

19. Applicant's arguments with respect to claims 1-66 have been considered but are moot in view of the new ground(s) of rejection.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached on Monday through Friday from 8:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592




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or 703-305-4456 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.



Alysia Berman  
Patent Examiner  
January 12, 2001



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